



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/600,744 07/20/00 SHIMIZU

H 2501USOP

023115 HM12/0829  
TAKEDA PHARMACEUTICALS NORTH AMERICA, IN  
INTELLECTUAL PROPERTY DEPARTMENT  
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EXAMINER

PULLIAM, A

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

08/29/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/600,744

Applicant(s)

SHIMIZU ET AL.

Examiner

Amy E Pulliam

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

## DETAILED ACTION

Receipt is acknowledged of the Preliminary Amendment A, received July 20 2000.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, and 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 394 050 A2 to Ueda *et al.*. Ueda *et al.* disclose a method of preparing a freeze dried preparation in which a first liquid is frozen, a second liquid is added to the frozen first liquid, and the frozen first and second liquids are freeze dried together, wherein one of the two liquids contains a pharmaceutically active compound or a preparation dissolved or suspended therein (p 11, claim 1). Ueda *et al.* further teach that the process takes place in a container (p 4, l 11). Claim 9 of the reference teaches that the liquids are frozen at temperatures of between –10 and –50°C. Example 5 of reference 1 teaches applicant's method of coating the inside of a container (vial) with ice, and then proceeding with the freeze drying steps. The teachings of Ueda *et al.* anticipate the limitations of applicant's above listed claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 394 050, as discussed above, and in view of the following comments.

Ueda *et al.* do not specifically disclose a layer of a water repelling substance. However, Ueda *et al.* do teach the used of at least two frozen layers of different liquids (p 3, l 55-57). Based on the generic teachings of Ueda *et al.*, one of ordinary skill in the art would have been motivated to perform the freeze drying process by lining a container (such as a vial) with ice, and an additional layer of a different liquid, and then proceeding with the freeze drying steps. There are no limitations in Ueda *et al.* as to what the second liquid may be. However, Ueda *et al.* do teach that one of the layers contains a pharmaceutical active suspended or dissolved therein (p 3, l 35-36). Therefore, it is the position of the examiner that if the desired active for the formulation is a hydrophobic active, then the skilled practitioner would use a hydrophobic layer in addition to the ice layer. If the desired active for the formulation is hydrophilic, the skilled practitioner could place the active in the water-ice layer, or use a hydrophilic liquid as the second layer. Either way, one of ordinary skill in the art would have been motivated to use either a hydrophobic or hydrophilic layer as the second layer to be

frozen in the container. The expected result would be a pharmaceutically acceptable lyophilized formulation.

Additionally, the purpose of applicant's claimed invention is to supply a process with a better yield of microspheres, with a reduced risk for entry of foreign substances. These are the same problems addressed in the Ueda *et al.* disclosure. Ueda *et al.* teach that their invention overcomes problems such as contamination, as well as faster and better recovery (p 3, l 1-35). Therefore, absent any evidence to the contrary, applicant's claimed invention achieves the same goal as that of the prior art, with no unexpected results. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is (703) 308-4710. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 305-3592 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

aep  
August 27, 2001

*LS Kishore*  
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Patent Examiner  
Group 16